

REMARKS

Claims 5 and 9 are pending. Applicants respectfully request reconsideration of the application in light of the arguments provided below and submit no new material is presented herein.

Claims Rejected—35 U.S.C. § 103

Claims 5 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,991,739 to Cupps et al. ("Cupps") in view of U.S. Patent No. 6,341,353 to Herman et al. ("Herman") and further in view of U.S. Patent No. 6,055,536 to Shimakawa et al. ("Shimakawa"). Applicants respectfully traverse the rejection for the following reasons.

Claim 9 recites a service providing area retrieval system including, among other features, a merchandise information database storing service request data of shops.

The Office Action **admits** that Cupps does not teach or suggest a merchandise information database storing service rest data of the shops. See the Office Action at page 4, lines 3-4. However, the Office Action asserts that "it is not novel in the art that a business or a restaurant or a vendor's system or site to have its own database for storing service requests [sic] data." *Id.* at page 4, lines 5-7. As such, the Office Action essentially takes official notice that such a feature is well-known in the art.

According to M.P.E.P. § 2144.03(A), official notice should only be taken where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. Notice of facts beyond the record which may be taken by the examiner must be "**capable of such instant and unquestionable demonstration as to defy dispute.**" *In re Ahlert*, 165 U.S.P.Q. 418, 420 (CCPA 1970). It is **not** appropriate for the Office Action to take

official notice of facts *without* citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known. M.P.E.P. § 2144.03(A). Further, it is ***never*** appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *In re Zurko*, 59 U.S.P.Q.2d 1693 at 1697 (Fed. Cir. 2001) (emphasis added).

The Office Action attempts to support its assertion that a merchandise information database storing service request data of the shops is well-known by asserting such a feature is taught by Herman. Particularly, the Office Action asserts that such a feature is taught in column 1, lines 49-26 and column 43, lines 4-67 of Herman.

Herman teaches a smart electronic receipt system that provides intelligent receipts, called Smart Receipts, that electronically document a transaction between two parties and maintains a persistent connection between the two parties. Moreover, the portion of Herman cited by the Office Action merely describes a Smart Receipt, according to the invention of Herman, and the method during which such a Smart Receipt is created. After exhaustively reviewing the cited portions of Herman, Applicants have been unable to identify any portion thereof teaching or suggesting a merchandise information database storing service request data of shops. More importantly, no portion of Herman cited by the Office Action teaches service request data of shops at all.

Rather, Herman teaches that Smart Receipts contains: a merchant verification of transaction with Key (LEDO); a detailed description of items purchased; a description of items; discounts—if applicable; and a shipping address. See Herman at column 43,

lines 52-59. Consequently, neither the Smart Receipt, nor any other portion of Herman cited by the Office Action teaches or suggests a merchandise information database storing service request data of shops, as recited in Claim 9.

Therefore, Applicants respectfully submit that not only is the feature of a merchandise information database storing service request data of shops, recited in Claim 9, not capable of instant and unquestionable demonstration as being well-known, but also such a feature is not taught or suggested by Herman.

Applicants also respectfully submit that none of the cited art references teach or suggest at least the features of: 1) a map information database storing mage image data; or 2) a retrieval server that displays a map image on which the destination and retrieved shops are respectively indicated with landmarks, and after a shop is selected based on the map image, connects the information terminal to the shop site of the selected shop, as recited in Claim 9. In fact, Applicants submit that the Office Action has failed to establish a *prima facie* case that any of the cited art references teach or suggest such features because the Office Action has failed to identify any portion of the cited art references allegedly teaching or suggesting such features. Accordingly, the Office Action implicitly **admits** that none of the cited art references teach or suggest these features.

Further, the Office Action has failed to provide any suggestion or motivation, either in the cited art references or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings in the manner asserted by the Office Action. Particularly, the Office Action has failed to offer any motivation as to why one of ordinary skill in the art would combine the particular portions of the cited art references in the manner asserted by the Office Action. Rather,

the Office Action merely asserts that such a combination would “allow users or customers to easily and quickly locate and purchase desired products or services on line thus help [sic] businesses grow faster.” See the Office Action at page 5, lines 3-6.

However, the Office Action does not identify where such a motivation exists in either the cited art references or anywhere else for that matter. Moreover, because there are three references forming the 35 U.S.C. § 103 obviousness rejection, the Office Action must provide a motivation for combining the teachings of each secondary reference to the teachings of the primary reference. That is, the Office Action must provide a motivation for combining the teachings of Herman with those of Cupps as well as a separate and distinct motivation to lead one skilled in the art to combine the teachings of Shimakawa with the combined teachings of Cupps and Herman. As such, the Office Action has completely failed to do satisfy its burden. Hence, Applicants submit that the motivation asserted by the Office Action is merely a *post hoc* attempt to justify improperly combining the features of Cupps, Herman, and Shimakawa. Thus, the asserted motivation is illusory, nonexistent, and improper.

Consequently, Applicants submit that the Office Action has resorted to hindsight reconstruction by using the Applicant’s disclosure as a blueprint to combine particular portions of the cited art references in a piecemeal fashion to allegedly result in the Applicants’ claimed invention. Such an attempt is impermissible and contrary to law. Moreover, Applicants submit that there is no motivation to combine the cited art references in the manner asserted by the Office Action. As such, Applicants respectfully submit that the combination of Cupps, Herman, and Shimakawa is improper.

In order to establish *prima facie* obviousness, all claim features must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974) and M.P.E.P. § 2143.03. Also, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *Id.* In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Therefore, because Cupps in view of Herman and Shimakawa, either alone or in combination, do not teach or suggest each and every feature recited in Claim 9, and because there is no motivation to combine the teachings thereof in the manner suggested by the Office Action, Applicants respectfully submit that Claim 9 is not rendered obvious for at least the reasons explained above.

Claim 5 depends from Claim 9. Therefore, Applicants submit that Claim 5 should be deemed allowable for at least the same reasons as Claim 9, as well as for the additional subject matter recited therein.

Accordingly, Applicant respectfully requests withdrawal of the rejection.

Conclusion

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, allowance of Claims 5 and 9, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing docket number 107156-00051.**

Respectfully submitted,
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